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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,815	10/24/2003	Gene DiPoto	ENDIUS.03/A	1092
28075	7590	07/08/2008	EXAMINER	
CROMPTON, SEAGER & TUFT, LLC			RAMANA, ANURADHA	
1221 NICOLLET AVENUE			ART UNIT	PAPER NUMBER
SUITE 800			3733	
MINNEAPOLIS, MN 55403-2420			MAIL DATE	DELIVERY MODE
			07/08/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/693,815	<b>Applicant(s)</b> DIPOTO, GENE
	<b>Examiner</b> Anu Ramana	<b>Art Unit</b> 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 08 April 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-39 is/are pending in the application.  
 4a) Of the above claim(s) 1-16, 18-23, 28-32, 33, 35 and 39 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 17, 19-22, 29-31, 34 and 36-38 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 4/8/08 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Drawings***

The drawings are objected to because of shading making details difficult to understand. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 26 and 47 of U.S. Patent No. 6,800,084 in view of Zucherman et al. (US 6,074,390).

Patented claims 2, 26 and 47 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 9, 17 and 25 of U.S. Patent No. 7,001,397 in view of Zucherman et al. (US 6,074,390).

Patented claims 3, 9, 17 and 25 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 16 of U.S. Patent No. 7,108,705 in view of Zucherman et al. (US 6,074,390).

Patented claims 6 and 16 disclose all elements of the claimed invention except for the type of surgical procedure.

Zucherman et al. supply the missing element by teaching placement of an intervertebral stabilization device in a minimally invasive manner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman et al. (US 6,074,390).

Zucherman et al. disclose a method of treating adjacent vertebrae in a spine of a patient including the steps of: inserting an access device or cannula through a minimally invasive incision in the skin of a patient; expanding the access device by placing a plurality of cannula wherein the first smaller cannula is followed by a successively larger cannula; inserting an implant made of an elastic material through the largest cannula; and utilizing fasteners to fasten the implant to the adjacent vertebrae (Figs. 39 and 40, col. 1, lines 26-49, col. 4, lines 18-28, col. 9, lines 13-67 and col. 10, lines 1-14).

Regarding claims 30 and 36, Zucherman et al. disclose an implant in the form of a spring (Fig. 59 and col. 12, lines 23-31).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19-22, 29-31, 34 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (US 6,074,390) in view of Davison et al. (US 6,187,000).

Zucherman et al. disclose all elements of Applicant's claimed invention except for a single access device or cannula having an expandable distal end.

Davison et al. teach the use of a cannula having an expandable distal end enabling an increase in the cross-sectional area of the distal end of the cannula.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted a single cannula with an expandable distal end for multiple cannulae of increasingly larger diameters to obtain the predictable result of increasing the cross-sectional area of the distal end of the access passage into the body.

#### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on April 4, 2008 have been fully considered but are not persuasive for the following reasons.

Contrary to Applicant's arguments, the Examiner reiterates that expanding the access device from a first configuration to a second configuration, does not preclude the use of additional devices placed over the access device, followed by removal of the access device resulting in an enlarged cross section. The Examiner reiterates that Zucherman et al. teach a method of expanding an access device by placement of additional access devices or cannulae of increasingly larger diameters, to expand the first cannula or access device from a first configuration or "arrangement" or "form" to a second "configuration" or "arrangement" or "form."

Regarding the rejections of claims 17, 19-22, 29-31, 24 and 36-38 under 35 USC 103(a) over Zucherman et al. in view of Davison et al., Zucherman et al. clearly disclose that a plurality of cannula can be used instead of one with each cannula being slightly bigger than the one before wherein the smaller cannula are withdrawn after the largest

cannula is in place with insertion of the implant through the largest cannula (col. 9, lines 48-57).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
July 2, 2008

/Anu Ramana/  
Primary Examiner, Art Unit 3733